REMARKS

In the Final Office Action, the Examiner rejected claims 1, 4-5, 7-9, 11, 20, and 26-30 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 7,177,642 to Sanchez-Herrero et al. (Herrero) in view of Rosenberg et al., "Caller Preferences and Callee Capabilities for the Session Initiation Protocol (SIP).[1]

By this amendment, Applicants amend claims 1, 11, and 20 to more clearly define the features of those claims, adds new claims 31 and 32 to claim subject matter to which Applicants are entitled, and cancels claim 23 without prejudice or disclaimer.

Claims 1, 4, 5, 7-9, 11, 20, and 26-32 are currently pending.

The Examiner rejected claims 1, 4-5, 7-9, 11, 20, and 26-30 under 35 U.S.C. §103(a) as unpatentable over Herrero in view of SIP. Applicants respectfully traverse this rejection.

The key consideration in a proper rejection under 35 U.S.C. 103(a) is not whether the pending claims can be used as a "shopping list" for searching of the prior art for descriptions of features for assembly in a manner that is allegedly similar to the claimed subject matter, but rather whether the prior art references, each taken in their entirety for all that they would reasonably teach to one of ordinary skill in the art at the time of the instant invention, would have rendered the instantly claimed subject matter unpatentably obvious. Unfortunately, the rejections proffered by the Office in this matter have emphasized the first approach in assembling piecemeal elements from several references to create an alleged basis for prima facie obviousness while failing to properly consider whether the cited references, when taken as a whole, properly suggest the instantly claimed subject matter in a manner that would have caused one of

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[1] Only the currently pending claims are listed.

ordinary skill in the art a the time of the present invention to have deemed it obvious.

Claim 1, as amended, recites the following features:

registering, in a controller entity comprising a call state control function, a
plurality of contact addresses for a user;
receiving, at the controller entity, a request for a communication link to the
user;
querying, by the controller entity, a database at a home subscriber server
for information regarding a manner regarding how to handle the request; and
processing, at the controller entity, the request based on the queried
information from the database, wherein, when provided during registration, the
controller entity uses user preference information to determine whether to fork
the request in parallel or sequentially.

Herrero generally discloses a method and system for handling multiple

registration. In particular, Herrero discloses supporting multiple registration from the

same user requested from different terminals in a telecommunications system requiring

to manage information related to the location of said user and related to the plurality of

identifiers that identify said user in said system. *See, e.g.,* Herrero, Abstract. However,

it is indisputable that the Herrero S-CSCF lacks any of the features recited in claim 1

with respect to the controller entity comprising a serving call state control function.

SIP discloses mechanisms to indicate "caller preferences." SIP at page 5.

Section 7 of SIP discloses extracting explicit preferences from header fields of a request

to determine caller preferences. SIP at pages 18-19. When the caller preferences are

not described in a header, the "proxy" extracts information from the request itself to form

an implicit preference. SIP at page 19. Rather than query a database at a home

subscriber server for any information, the SIP proxy determines a forking preference

from the request.

In view of the foregoing, neither <u>Herrero</u> nor <u>SIP</u> discloses or suggests at least the following features of claim 1: "querying, by the controller entity, a database at a home subscriber server for information regarding a manner regarding how to handle the request" and "processing, at the controller entity, the request based on the queried information from the database, wherein, when provided during registration, the controller entity uses user preference information to determine whether to fork the request in parallel or sequentially."

Therefore, claim 1 is allowable over <u>Herrero</u> and <u>SIP</u>, whether taken alone or in combination, and the rejection under 35 U.S.C. §103(a) of claim 1 as well as claims 4, 5, and 7-9, at least by reason of their dependency, should be withdrawn.

Independent claims 11 and 20, although of different scope, include similar features with respect to claim 1. For at least the reason given above with respect to claim 1, claims 11 and 20, as well as claims 25-30, at least by reason of their dependency, are allowable over <u>Herrero</u> and <u>SIP</u>, whether taken alone or in combination, and the rejection under 35 U.S.C. §103(a) of those claims should be withdrawn.

Regarding the motivation to combine, Applicants submit that the Examiner's proposed combination, which relies on <u>Herrero</u> and <u>SIP</u>, would fundamentally change the principle of operation of these reference and likely lead to an inoperative system. *See* M.P.E.P 2143.03("[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959))." See also *Ex Parte*

Toftness, 2008 WL 4451384 (Bd. Pat. App. & Int 2008) (reversing the Examiner's

section 103 rejection as the proposed combination would yield an inoperative device).

Specifically, the fundamental principle of operation of SIP relies on a proxy

extracting information from a request from a caller, which implicitly indicates the

preferences of the caller. SIP at pages 18-19. Therefore, there is no reason for the SIP

proxy to subsequently contact a database at a home subscriber server to determine

forking preferences, as the Examiner's modifications would require. Moreover,

modifying the proxy as the Examiner proposes would likely lead to an inoperative

system as there might be conflicts in user preferences between the proxy's implicit

preferences and preferences found in a database. Because there is no motivation to

combine, the rejection under 35 U.S.C. § 103(a) of rejected claims 1, 4-5, 7-9, 11, 20,

and 26-30 should be withdrawn for this additional reason.

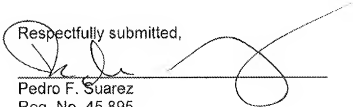New claims 31 and 32 are allowable for at least the reasons given above.

CONCLUSION

On the basis of the foregoing amendments, the pending claims are in condition for allowance. It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Applicant is concurrently filing herewith a Petition for a one-month extension of time and Request for Continued Examination with the requisite fee. Authorization for a credit-card payment of the filing fees mentioned above is submitted herewith. No additional fees are believed to be due, however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 39700-793001US/NC39973US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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